

REMARKS

Applicants have studied the Office Action dated March 25, 2005 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 17-20, 22, and 24-40 are pending. Claims 17, 19, 22, 24 and 28 are amended. Claims 29-40 are new. No claims are canceled. Applicants have made numerous, small editorial changes to the specification to correct grammatical and other errors, and to enhance readability. No new matter was added by these changes. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

Rejection under 35 U.S.C. § 102(a)

The Examiner rejected claims 17-20, 22 and 24-28 under 35 U.S.C §103(a) as being unpatentable over Mazzagatte et al., (U.S. Pat. No. 6,862,583), hereinafter "Mazzagatte", in view of Adamske et al., (U.S. Pat. No. 6,615,234), hereinafter "Adamske". Applicants have amended independent claims 17, 22 and 24 for clarity to more clearly and distinctly recite the present invention. Specifically, claims 17, 22 and 24 now more clearly recite that a document is transmitted through a two-way communications system to an address of a presentation device "*using one bidirectional communications protocol*", and that a record of identifying data used to produce said print command is transmitted through said two-way communications system "*using said one bidirectional communications protocol*" [emphasis added]. In other words, a single, i.e., the same, **bidirectional communications protocol** is used both for transmitting the document and for transmitting back the record of identifying information. New dependent claims 31, 36, 39 and 40 have been added which recite that the one bidirectional communications protocol comprises one of: "*an Internet Printing Protocol (IPP), an Internet FAX (IFAX) protocol and an Intelligent Printer Data Stream (IPDS)*". Support for the amended language is found in the original specification and claims as filed. See, for example, page 6, lines 16-20. No new matter was added by these amendments.

BLD9-1999-0018US1

14 of 18

09/526,622

Regarding independent claim 17, the Mazzagatte and Adamske references, either taken singly or in combination, do not suggest all the steps of amended claim 17. In particular, the combination of Mazzagatte and Adamske does not suggest, the steps of:

"transmitting a document from a system device through a two-way communications system to an address of a presentation device, using one bidirectional communications protocol;" and

"transmitting said record through said two-way communications system using said one bidirectional communications protocol",

as recited in the first and seventh steps of amended claim 17.

The Examiner stated that Adamske discloses the step of transmitting a record of at least one of a time, a date, and a location of access to data. However, to be more precise, Adamske transmits an **email notification** to confirm that the hard copy documents were delivered or picked up. See col. 4, lines 35-39 of Adamske. Such an email notification uses, by definition, an email communications protocol. An email communications protocol is not the same as a printing protocol that is used with the Applicant's invention. The applicants' invention does not use an email communications protocol to transmit a notification. The email communications protocol used in Adamske is disadvantageously, a second, additional protocol above and beyond any printing protocol used in Adamske's document delivery system. In the Applicants' invention, the protocol used to print the document and the protocol used to transmit the notification of the printing of the document is, advantageously, one and the same protocol. Adamske does not disclose, teach or suggest using a single bidirectional communications protocol for both actions.

Regarding independent claim 22, the Mazzagatte and Adamske references, either taken singly or in combination, do not suggest all the steps of amended claim 22. In particular, the combination of Mazzagatte and Adamske does not suggest, the steps of:

"transmitting a document from a system through a two-way communications system to an address of a presentation device, using one bidirectional communications protocol;" and

"transmitting said record through said two-way communications system using said one bidirectional communications protocol",

as recited in the first and seventh steps of amended claim 22. Reconsideration and allowance of amended claim 22 is requested for the same reasons set forth above regarding amended claim 17.

Regarding independent claim 24, the Mazzagatte and Adamske references, either taken singly or in combination, do not suggest all the elements of amended claim 24. In particular, the combination of Mazzagatte and Adamske does not suggest, the steps of:

"an output for sending the file to an output device as a direct response to the entry of the identification data and without authentication, using one bidirectional communications protocol;" and

"a transmitter for sending, through said two-way communications system, a notification of the output of the file to the output device and the identification information of the user to at least one designated party, using said one bidirectional communications protocol",

as recited in the fourth and fifth elements of amended claim 24. Reconsideration and allowance of amended claim 24 is requested for the same reasons set forth above regarding amended claim 17.

The prior art made of record and not relied upon, Nezu (U.S. Patent No. 5,638,511), was reviewed by Applicants and is not considered pertinent to Applicants' disclosure.

CONCLUSION

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all the grounds for rejection stated in the Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: June 27, 2005

By: 

Jon Gibbons, Reg. No. 37,333
Attorney for Applicants
FLEIT, KAIN, GIBBONS,
GUTMAN, BONGINI & BIANCO, P.L.
551 N.W. 77th Street, Suite 111
Boca Raton, FL 33487
Tel (561) 989-9811
Fax (561) 989-9812

Please Direct All Future Correspondence to Customer Number **23334**